

## **REMARKS**

### **A. Introduction**

The Final Office Action dated December 23, 1997 (Final Office Action) has been carefully reviewed and the foregoing amendments made in response thereto.

Claims 3, 13, 17, 19, 22, 27, 35, 39 and 43 are amended. Claims 3-46 are pending in the application.

Claims 3-46 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Campbell, et al., U.S. Pat. No. 4,536,791 (hereinafter "Campbell").

Claims 3-46 remain active in this application. No new matter is presented in the foregoing amendments. Approval and entry of same is respectfully requested.

### **B. Double Patenting Issues**

#### **1. Double Patenting with Related Co-Pending Applications**

Applicants respectfully traverse the requirements of the Office Action paragraph 5 based on 37 CFR 1.78(b).

It is stated in the Office Action that the Applicants are required to either:

(1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; or

(2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or

(3) resolve all conflicts between claims in the related 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications.

In addition, Examiner states that failure to comply with any one of these requirements will result in abandonment of the application.

Examiner states that the requirement has been made because conflicts exist between claims of the related co-pending applications, including the present application. Examiner sets forth only the serial numbers of the co-pending applications without an indication of which claims are conflicting. Examiner has also attached an Appendix providing what is deemed to be clear evidence that conflicting claims exist between the 328 related co-pending applications and the present application. Further, Examiner states that an analysis of all claims in the 328 related co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

Applicants respectfully traverse these requirements because Examiner has both improperly imposed the requirements, and has incorrectly indicated that abandonment will occur upon failure to comply with the requirement. Applicants' traversal is supported by the fact that 37 C.F.R. § 1.78 (b) does not, under the present circumstances, provide Examiner with authority to require Applicants to either: 1) file terminal disclaimers; 2) file an affidavit; or 3) resolve all apparent conflicts. Additionally, the penalty of abandonment of the instant application for failure to comply with the aforementioned requirement is improper for being outside the legitimate authority to impose abandonment upon an application.

**a. The PTO's New Requirement is an Unlawfully Promulgated Substantive Rule Outside the Commissioner's Statutory Grant of Power**

The PTO Commissioner obtains his statutory rulemaking authority from the Congress through the provisions of Title 35 of the United States Code. The broadest grant of rulemaking authority, 35 U.S.C. § 6 (a), permits the Commissioner to promulgate regulations directed only to "the conduct of proceedings in the [PTO]". This provision does NOT grant the Commissioner authority to issue substantive rules

of patent law. Animal Legal Defense Fund v. Quigg, 932 F.2d 920, 930, 18 U.S.P.Q. 2d 1677, 1686 (Fed Cir. 1991).<sup>1</sup> Applicants respectfully submit that the Examiner's creation of a new set of requirements based upon 37 CFR § 1.78(b) constitutes an unlawful promulgation of a substantive rule in direct contradiction of a long-established statutory and regulatory scheme.

**b. The PTO's Requirement is a Substantive Rule**

The first determination is whether the requirement as imposed by the PTO upon Applicants is substantive or a procedural rule. The Administrative Procedure Act offers general guidelines under which all administrative agencies must operate. A fundamental premise of administrative law is that administrative agencies must act solely within their statutory grant of power. *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). The PTO Commissioner has NOT been granted power to promulgate substantive rules of patent law. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing, *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 U.S.P.Q.2d 1677, 1686 (Fed. Cir. 1991).

The appropriate test for such a determination is an assessment of the rule's impact on the Applicant's rights and interests under the patent laws. *Fressola v. Manbeck*, 36 U.S.P.Q.2d 1211, 1215 (D.D.C. 1995). As the PTO Commissioner has no power to promulgate substantive rules, the Commissioner receives no deference in his interpretation of the statutes and laws that give rise to the instant requirement. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed Cir. 1996), citing, *Chevron v. Natural Resources*

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<sup>1</sup> Accord Hoechst Aktiengesellschaft v. Quigg, 917 F.2d 522, 526, 16 U.S.P.Q.2d 1549, 1552 (Fed Cir. 1990); Glaxo Operations UK Ltd. v. Quigg, 894 F.2d 392, 398-99, 13 U.S.P.Q.2d 1628, 1632-33 (Fed. Cir. 1990); Ethicon Inc. v. Quigg, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d 1152, 1154 (Fed. Cir 1988).

*Defense Council*, 467 U.S. 837 (1984). When agency rules either (a) depart from existing practice or (b) impact the substantive rights and interests of the effected party, the rule must be considered substantive. *Nat'l Ass'n of Home Health Agencies v. Scheiker*, 690 F.2d 932, 949 (D.C. Cir. 1982), *cert. denied*, 459 U.S. 1205 (1983).

**c. The New Requirement is a Substantive Rule because it Adversely Impacts the Rights and Interests of Applicants to Benefits of the Patent**

The rights and benefits of a U.S. patent is solely a statutory right. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed Cir. 1996). The essential statutory right in a patent is the right to exclude others from making, using and selling the claimed invention during the term of the patent. Courts have recognized that sometimes new procedural rules of the PTO are actually substantive rules, e.g. when the new rule made a substantive difference in the ability of the applicant to claim his discovery. *Freesola v. Manbeck*, 36 U.S.P.Q.2d 1211, 1214 (D.D.C. 1995) (emphasis added), citing, *In re Pilkington*, 411 F.2d 1345, 1349; 162 U.S.P.Q. 145 (C.C.P.A. 1969); and *In re Steppan*, 394 F.2d 1013, 1019; 156 U.S.P.Q. 143 (C.C.P.A. 1967).

The new requirement, on its face and as applied here, is an instance of a PTO rule making a substantive difference in Applicants ability to claim their invention and, therefore, must be considered a substantive rule. The requirement denies Applicants rights and benefits expressly conferred by the patent statute. The measure of the value of these denied rights and benefits is that the requirement, as applied here, would deny Applicants the full and complete PTO examination of Applicants' claims on their merits, as specified by 37 C.F.R. § 1.105. In addition, to file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications based on the PTO's incomplete examination on the merits would deny Applicants' the

benefit of the full patent term of 17 years on each of Applicants' respective applications. Applicants respectfully submit that the requirement has a huge impact on their rights and interests in the presently claimed invention.

**d. The PTO Requirement is Substantive because it Changes Long Existing Patent Practice by Creating a New Requirement Upon Applicants which is Outside the Scope of 37 C.F.R. §1.78(b)**

The Examiner's requirement is distinguishable from the well articulated requirement authorized by 37 CFR § 1.78 (b), because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the claims. Long existing patent practice recognizes only two types of double patenting: double patenting based on 35 U.S.C. § 101 (statutory double patenting) and double patenting analogous to 35 U.S.C. § 103 (the well-known obviousness type double patenting).<sup>2</sup> These two well established types of double patenting use an objective standard to determine when they are appropriate<sup>3</sup> and have a determinable result on the allowability of the pending claims.

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<sup>2</sup>MPEP § 804(B)(1) states that the inquiry for obviousness type double patenting is analogous to a rejection under 35 U.S.C. 103, "since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103 rejection, the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis".

<sup>3</sup> The objective test for same invention double patenting is whether one of the claims being compared could be literally infringed without literally infringing the other. The objective test for obviousness type double patenting is the same as the objective nonobviousness requirement of patentability with the difference that the disclosure of the first patent may not be used as prior art.

The Examiner's new requirement represents a radical departure from long existing patent practice relevant to conflicting claims between co-pending applications of the same inventive entity. Two well established double patenting standards are based on an objective analysis of comparing pending and *allowed* claims. However, in the present application, there are no *allowed* claims. The Examiner's new requirement to avoid a double patenting rejection presumes that conflicts exist between claims in the present application and claims in the 327 copending applications. This presumption of conflicts between claims represents a substantial departure from long existing patent practice as defined by 37 C.F.R. § 1.78 (b), which states:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Clearly, the only requirement authorized by the rule is the elimination of claims from all but one application where conflicting claims have been determined to exist. Furthermore, in order to determine that conflicting claims do in fact exist in multiple applications, the only possible analysis is obviousness-type double patenting, since there are no allowed or issued claims by which to employ the 35 U.S.C. § 101 statutory double patenting analysis. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

In summary, the Examiner's new requirement departs from long-established practice because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the claims.

Therefore, the Examiner's new requirement departs from existing practice and therefore is a **substantive rule** beyond the authority of the PTO and is therefore, invalid.

e. **The PTO Requirements are Outside the Scope of 37 C.F.R. § 1.78(b)**

The only **requirement** that 37 C.F.R. § 1.78 (b) authorizes is the elimination of conflicting claims from all but one of the co-pending applications.

In this Office Action, the Examiner has not required the elimination of all conflicting claims from all but one application, but instead has required Applicants to: 1) file terminal disclaimers in each of the related 328 applications; 2) provide an affidavit; or 3) resolve all conflicts between claims in the related 328 applications. None of the options in the requirement is authorize by 37 C.F.R. § 1.78 (b), and therefore Applicants respectfully submit that such a requirement is improper.

With respect to the PTO's authority to act within 37 C.F.R. § 1.78 (b) regarding the rejection of conflicting claims, M.P.E.P § 822.01 states that:

Under 37 CFR § 1.78 (b), the practice relative to overlapping claims in applications copending before the examiner..., is as follows: Where claims in one application are unpatentable over claims of another application of the same inventive entity because they recite the same invention, *a complete examination should be made of the claims of each application* and all appropriate rejections should be entered in each application, including rejections based upon prior art. *The claims of each application may also be rejected on the grounds of **provisional** double patenting on the claims of the other application* whether or not any claims avoid the prior art. Where appropriate, the same prior art may be relied upon in each of the applications. MPEP 822.01 (6th Ed., Rev. 3, 1997), (*emphasis added*).

In light of the requirements of this Office Action, M.P.E.P § 822.01 and 37 CFR § 1.78 (b) are not applicable since there has not been any rejection with regard to the elimination of conflicting claims from all but one co-pending application.

**f. The Assertion that the Failure to Comply with the Requirement Will Result in Abandonment of Applicants' Application is Improper**

Applicants' prospective failure to comply with the above requirements cannot properly result in abandonment of the present application. Applicants respectfully submit that abandonment of an application can properly occur only:

- (1) for failure to respond within a provided time period (under 37 C.F.R. § 1.135);
- (2) as an express abandonment (under 37 C.F.R. § 1.138 ); or
- (3) the result of failing to timely pay the issue fee (under 37 C.F.R. § 1.316).

There is no provision in the rules permitting abandonment for failure to comply with any of the presented requirements. To impose an improper requirement upon Applicants and then hold the application is to be abandoned for failure to comply with the improper requirement violates the rules of practice before the USPTO.

Furthermore, Examiner is in effect attempting to create a substantive rule which is above and beyond the rulemaking authority of the USPTO, and therefore is invalid.

In the *Application of Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976), the applicant had conflicting claims in multiple applications. The CCPA held that action by Examiner which would result in automatic abandonment of the application was legally untenable. *Id.* at 1296, 190 USPQ at 541. In the present application, Examiner has asserted that there are conflicting claims in multiple applications, and that non-compliance of the requirements will result in an automatic abandonment. Therefore, under *Mott's* analysis, the result of abandonment of Applicants' present application is legally untenable.

**g. Response to Apparent Conflict of Claims**



Applicants submit that the presentation of the Appendix fails to demonstrate any conflicts between claims of the present application and claims of the co-pending applications. Rather, the Appendix compares representative claims of *other* applications in an attempt to establish that “conflicting claims exist between the 328 related co-pending applications.” Absent any evidence of conflicting claims between the Applicants’ present application and any other of Applicants’ co-pending applications, any requirement imposed upon Applicants to resolve such alleged conflicts is improper.

#### **h. Request for Withdrawal of Requirement**

Applicants respectfully request that Examiner reconsider and withdraw the requirement that Applicants: (1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; (2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or (3) resolve all conflicts between claims in the above identified 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications, which upon failing to do so will abandon the application.

### **3. Filing of Supplemental Oath**

Notwithstanding the foregoing, Applicants will file a supplemental oath under 37 C.F.R. § 1.67 for each application when Examiner identifies allowable subject matter.

Applicants respectfully propose that the filing of individual supplemental oaths attesting to the absence of claim conflicts between previously patented claims and subsequently allowed claims is a more reasonable method of ensuring the patentable distinctness of subsequently allowed claims.

Under 37 C.F.R. § 1.105, § 1.106 & § 1.78 (b), Examiner has the duty to make every applicable rejection, including double patenting rejection. Failure to make every proper rejection denies Applicants all rights and benefits related thereto, e.g., Applicants' right to appeal, etc. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

### **C. Information Disclosure Statement**

The Applicants appreciate the Examiner's review of the Information Disclosure Statement filed April 7, 1997 and have addressed those specific concerns raised in the office action. It is the Applicants' understanding that the Examiner raised the following 5 issues:

- (1) the reasons for such a large number of references cited,
- (2) foreign language references cited without a statement of relevance or translation have not been considered,
- (3) the relevancy of numerous references listed in the Information Disclosure Statements are subsequent to the Applicants' latest effective filing date of 11/3/81,
- (4) citation of references apparently unrelated to the subject matter of the claimed invention, and
- (5) citation of database search results listed in foreign languages where no copy was provided.

### 1. Reason for Citation of Large Number of References

The reason that the Applicants submitted such a large number of references in the Information Disclosure Statements was that a large portion of the information cited by the Applicants was brought to the Applicants' attention in the discovery processes in a previous litigation in the United States District Court for the Eastern District of Virginia (*Personalized Mass Media Corp. v. The Weather Channel, Inc.* Docket No. 2:95 cv 242) and an investigation by the International Trade Commission (*In the Matter of Certain Digital Satellite System (DSS) Receivers And Components Thereof*, No. 337 TA 392, which was direct to U.S. Pat. No. 5,335,277) regarding claims in the Applicants' related issued patents. The documents listed in the Information Disclosure Statement were cited during the previous litigation/investigative proceedings by the alleged infringers in the aforementioned proceedings as being relevant and material to patentability of the claims in the related patents. The Applicants submitted those materials in the Information Disclosure Statement to the PTO at the earliest possible time in order to file them in compliance with the 3 month requirement stated in the certification used to submit the Information Disclosure Statement before the Final Office Action was issued as is necessary under 37 CFR § 1.97 (c) (1). In such haste, entries were inadvertently submitted which do not appear on their face to be material to the patentability of the present application. Applicants have corrected this error with the submission of the corrected Information Disclosure Statement as shown in Appendix B. However, it is the Applicants' understanding that not all references cited must be material to patentability in order for such references to be considered. In § 609 of the MPEP, it states,

“[t]hese individuals also may want the Office to consider information for a variety of reasons: e.g., without first determining whether the information meets any particular standard of materiality, or because another patent office considered the information to be relevant in a counterpart or related patent application filed in another country, or to make sure that the examiner has an opportunity to consider the same information that was

considered by the individuals that were substantially involved in the preparation or prosecution of a patent application.”

Applicants’ position is that information that was considered material in previous litigation would fall into the ‘variety of reasons’ category as stated above. Applicants intention was not to confuse or make difficult the examination process for the Examiner, but was instead to be forthright and open in disclosing all information deemed to be relevant to the application in issue by third parties.

## **2. Citations of Foreign Language References**

Applicants have re-examined the foreign references listed in all of the Information Disclosure Statements and have either eliminated such references from the list, included translations herewith or provided statements as to the relevancy of such references (APPENDIX A). The inclusion of translations with this response is in compliance with 37 C.F.R. § 1.97 (f) which states in part, “[I]f a bona fide attempt is made to comply with 37 C.F.R. § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.” The omission of any translations and/or relevancy statements for foreign references were inadvertent and unintentional and are herein submitted in accordance with 37 C.F.R. § 1.97 (f).

## **3. References in the Information Disclosure Statements Subsequent to Applicants’ Latest Effective Filing Date of 09/11/87**

Examiner stated “[n]umerous references listed in the IDS are subsequent to the applicant’s latest effective filing date of 9/11/87, therefore, the relevancy of those references is unclear.” Upon further examination, the Applicants have eliminated those patents and publications after the effective filing date for the present application. It is the Applicants’ understanding that the effective filing date for the present application is 11/03/81. The effective filing date for the present application is November 3, 1981 and

the aforementioned references were the only references determined not to be prior art because of their dates.

#### **4. Citation of Unrelated References**

Applicants appreciate the Examiner pointing out such references that were listed yet on their face appear to be unrelated to the subject matter of the present application. In response to such information, the Applicants have reviewed the cited references and removed any such references which appear to be unrelated on their face to the claimed subject matter such as the patent for a beehive, the patent for a chemical compound and numerous computer printout search results.

#### **5. Citation of Database Search Results**

Database search results listed in foreign languages where no copy was provided have been eliminated from the substitute Information Disclosure Statement included with this office action.

The Applicants' offer the corrected Information Disclosure Statement (APPENDIX B) as a substitute to the previously filed Information Disclosure Statement filed 04-07-97. No new entries have been entered, only citations which have, upon further examination, been determined not to be relevant to the claimed subject matter have been eliminated, typographical errors have been corrected, dates inserted where possible and the list shortened as a result. It is the Applicants' intention that such corrected Information Disclosure Statement will help clarify any issues previously raised by the Examiner and aid in the prosecution of the present patent application.

#### **D. Rejections under 35 U.S.C. §102**

The Examiner's comments on the claims are acknowledged and appreciated. In response thereto, claims 3, 13, 17, 19, 22, 27, 35, 39 and 43 have been amended. The foregoing amendments present no new matter and are fully supported by the specification as filed.

Applicants respectfully submit that the applied reference, Campbell, is not prior art under 35 U.S.C. § 102(a) for the subject matter relied upon by the Examiner at least as to claims 3-21 and 27-34. A person shall be entitled to a patent unless the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent. 35 U.S.C. § 102(a). In the present case, the 102(a) date on the face of the Campbell patent, October 15, 1981, does not precede the invention by the applicants. In particular, submitted herewith is a declaration of applicant John C. Harvey that the evidence also submitted indicates the conception of the invention claimed in at least claims 3-21 and 27-34. Therefore, as to at least claims 3-21 and 27-34, Campbell is not prior art and the claims are allowable as recited.

Notwithstanding the foregoing, Applicants submit that Campbell does not anticipate the claimed invention as amended. Campbell is directed to a head end station that includes a central data system using a control computer which gathers data from a wide variety of sources and formats the data for transmission on video frequency channels. The formatted data is then transmitted by communication link to a television program processor where it is incorporated into the vertical blanking intervals of video signals by a variety of television program sources. The head end unit transmits the combined cable television and data signal to remote subscribers. Normally, the signals are then transmitted through a cable network to a plurality of subscribers. The signals are received by an addressable converter which then processes the data on line as determined by subscriber input for desired viewing on one or more television sets.

Regarding amended claim 3, Applicants traverse the rejection and submit that the control data and subscriber codes of Campbell do not anticipate the receiver specific programming presentation of claim 3. For example, Figure 1 of Campbell discloses the

output of a conventional broadcast along with text that, upon display, is the same at every receiver station with access that tunes to the appropriate channel. In contrast, the receiver station of claim 3 receives a receiver-specific programming presentation and selects at least one stored subscriber datum with independent receiver-specific relevance at each receiver station. At best, Campbell distinguishes users on a tier level, whereas claim 3 independently distinguishes output on an individual user level that may differ at each receiver station.

Regarding independent claim 13, Applicants traverse the rejection and submit that the control data and enable codes of Campbell do not anticipate the selected subscriber datum for simultaneous or sequential presentation, as found in claim 13. Campbell discloses that the channel enable code, text enable code, and subscriber enable word control access to universally-broadcast signals and textual data to authorize a subscriber to view information on a given channel at a specific time. For example, the text enable word (219) identifies the channels which are available for viewing by the identified subscriber. (Campbell, col. 13, lines 46-48).

Unlike Campbell, however, amended claim 13 recites that downloadable code is effective at the receiver stations to select at least one subscriber datum. As noted earlier, the subscriber datum of the present application has independent receiver-specific relevance at each receiver station, whereas Campbell distinguishes access and authorization merely on a subscriber tier level. Further, Campbell's addressable cable television control system is completely silent on "at least one subscriber datum for at least one of simultaneous presentation and sequential presentation of said at least one subscriber datum with mass medium programming."

Regarding independent claim 17, Applicants traverse the rejection and submit that Campbell's channel monitoring for test marketing purposes does not anticipate the method of gathering information on the use of a resource or signal of claim 17.

Campbell discloses that, if permitted by the subscriber, converter 40 is enabled to transmit certain television set monitoring information such as: (1) an indication that the subscriber's set is turned on; (2) the channel it is turned to; and (3) when the subscriber moves from one channel to another. (Campbell, col. 18, lines 14-23). This monitoring capability can be used for rating television programs and, in conjunction with the opinion polling capability, for test marketing of products. (Campbell, col. 18, lines 23-26).

In contrast, claim 17 recites identifying at least one of: (a) a resource to select for at least one of simultaneous presentation and sequential presentation with mass medium programming; and (b) a control signal which is effective to select at least one subscriber datum for said at least one of simultaneous presentation and sequential presentation with said mass medium programming. The object and effect of Campbell's channel monitoring is to rate television programs and market products, whereas the object and effect of claim 17 is to gather information on the use of at least one of a resource and a control signal. Moreover, Campbell does not disclose a control signal that selects at least one subscriber datum with independent receiver specific relevance, as found in claim 17.

Regarding independent claim 19, Applicants traverse the rejection and submit that Campbell's control data, subscriber enable word, and text identification code do not anticipate the instruct signal of claim 19. Campbell's subscriber enable word and text identification code provide only a basic on/off functionality for programming, whereas independent claim 19 recites receiving mass medium programming having an instruct signal which is effective to select at least one subscriber datum for simultaneous or sequential presentation with the mass medium programming. The object and effect of Campbell's subscriber enable word and text identification code is to provide access authorization to universally-broadcast programming, whereas the object and effect of



claim 19 is to use an instruct signal to output a simultaneous or sequential presentation of at least one selected subscriber datum with independent receiver specific relevance, with the mass medium programming.

Regarding independent claim 22, Applicants traverse the rejection and submit that the text identification code of Campbell does not anticipate the instruct signal of claim 22. Amended claim 22 recites "receiving at said transmitter station an instruct signal which is effective at the receiver station to select said at least one subscriber datum for at least one of simultaneous and sequential presentation with said mass medium programming." The Office Action states that Campbell teaches the step of "receiving at the transmitter station an instruct signal (see the text identification code 252 in figure 11) . . .". Applicants respectfully disagree with the Examiner's cross-reference and citation. The text identification code of Campbell does not select subscriber data for simultaneous or sequential presentation with mass medium programming. Rather, the text identification code merely indicates the start of text to facilitate the formatting of a text data transmission. In addition, Campbell does not teach a subscriber datum having independent receiver specific relevance.

Campbell also does not teach or suggest "receiving at least one of a code or datum" which "designates at least one of a product and a service offered in said mass medium programming and the subscriber reaction." Campbell teaches only receiving a reply to a menu and no code and/or datum that indicates any product on the menu and the reaction.

Campbell does not teach or suggest receiving any "instruct signal" which is effective to select at least one subscriber datum. Therefore, Campbell fails to teach or suggest the steps of receiving, transferring, and transmitting such an instruct signal as recited in claim 22.

Regarding independent claim 27, Applicants traverse the rejection and submit that the control data and text enable code of Campbell do not anticipate the instruct signal of claim 27. Campbell discloses that the channel enable code, text enable code, and subscriber enable word control access to universally-broadcast signals and textual data to authorize a subscriber to view information on a given channel at a specific time. Further, the text enable word (219) identifies the channels which are available for viewing by the identified subscriber. (Campbell, col. 13, lines 46-48).

Unlike Campbell, however, amended claim 27 recites that at least one instruct is effective at the receiver stations to select said at least one subscriber datum for simultaneous or sequential output with mass medium programming. Further, Campbell's text formatter system generates output information content such as teletext (no prompting) for program selection, but the output is not transmitted with the capability to inter-relate at least one instruct signal, at least one control signal, mass medium programming, and at least one subscriber datum with independent receiver specific relevance, as found in claim 27. Campbell's teletext data (no prompting) is transmitted to all receiver stations broadcast-fashion and only enables the receiver to format and display the universally-broadcast textual data.

Campbell does not teach or suggest receiving any "instruct signal" which is effective to select at least one subscriber datum or any "control signal" identifying at least one receiver station device to which the instruct signal is addressed. Therefore, Campbell fails to teach or suggest the steps of receiving and transferring one or both of the instruct signal or control signal as recited in claim 27.

Regarding independent claim 35, Applicants traverse the rejection and submit that Campbell's information retrieval feature does not anticipate the assembling, delivering, outputting or selecting steps of claim 35. Campbell discloses that "[t]he information retrieval feature allows a wide variety of information to be accessed from

libraries and other data banks." (Campbell, col. 18, lines 30-33). The converter is linked to a remote data bank by way of a PCS unit control computer. (Campbell, col. 18, lines 40-44).

Amended claim 35, however, includes much more than controlling information retrieval from libraries and data banks. Among other things, claim 35 recites the steps of: (1) assembling, in the network, at least a first signal which is effective at the interactive television viewing apparatus to deliver said at least one subscriber datum for simultaneous or sequential presentation with the mass medium programming; and (2) outputting said at least one subscriber datum in a simultaneous or sequential presentation with the mass medium programming based on said at least said first signal from a remote station.

Campbell's information retrieval system neither assembles the first signal of claim 35 nor outputs the subscriber datum with independent interactive television viewing apparatus specific relevance of claim 35. Further, the object and effect of Campbell's information retrieval system is to allow access to static data, whereas the object and effect of claim 35 is to actually assemble and output a simultaneous or sequential presentation of mass medium programming and at least one subscriber datum based on a first signal from a remote station.

Further, Campbell does not contain any teaching or suggestion of "displaying television programming that promotes mass medium programming." Mass medium includes television, radio, and print medium. Campbell does not teach or suggest an apparatus "capable of storing at least one subscriber datum with independent interactive television viewing apparatus specific relevance." Campbell does not store any information at all.

In addition, Campbell does not disclose, teach, or suggest or imply the features in claim 35 of prompting the subscriber for a response, receiving the subscriber's reply,

processing the reply and selecting at least one stored code or datum which is different from the reply, and communicating the selected code or datum to a remote site.

Campbell only teaches receiving a subscriber selection based on a menu the subscriber has chosen to output (no prompting involved) and sending the reply to the head end. Applicants' claim 35 also includes the feature of assembling, in said network, at least a first signal message which is effective at the apparatus to deliver at least one subscriber datum. Campbell only teaches sending a reply to the head end which in turn allows access to programming. No assembling is performed by the head end in the network of at least one first signal. This is apparent because Campbell teaches or suggests only sending a reply to the head end and does not teach any assembling.

Regarding independent claim 39, Applicants traverse the rejection and submit that Campbell's information retrieval feature also does not anticipate the assembling, delivering, outputting or selecting steps of claim 39. As noted earlier, Campbell discloses that the information retrieval feature allows a wide variety of information to be accessed from libraries and data banks by linking the converter to a remote data bank. (Campbell, col. 18, lines 33-44). Unlike Campbell's information retrieval system, however, amended claim 39 recites processing instructions to select said at least one subscriber datum for simultaneous or sequential presentation with the mass medium programming. Campbell's information retrieval system merely operates to allow access to static data, whereas claim 39 actually processes instructions to output a simultaneous or sequential presentation of mass medium programming and at least one subscriber datum with independent interactive mass medium specific relevance. Moreover, claim 39 presents the information in a specific fashion, on the basis of instructions, to complete or supplement the mass medium programming.

Further, Campbell does not contain any teaching or suggestion of "displaying mass medium programming that promotes a specific fashion of presenting information

to one of complete and supplement said mass medium programming." Campbell does not teach or suggest an apparatus "capable of storing at least one subscriber datum with independent interactive mass medium programming output apparatus specific relevance." Campbell does not store any information at all.

In addition, Campbell does not disclose, teach, or suggest or imply the features in claim 39 of prompting the subscriber for a response, receiving the subscriber's reply, processing the reply and controlling delivery in response to instructions different from the reply, and the instructions effective to select at least one subscriber datum." Campbell only teaches receiving a subscriber selection based on a menu the subscriber has chosen to output (no prompting involved) and sending the reply to the head end. Applicants' claim 39 also includes the step of presenting information other than the mass medium selected by the subscriber to complete and/or supplement the mass medium programming. Campbell only teaches displaying television as opposed to mass medium and has no concept of completing and/or supplementing the television program with information selected by the subscriber.

Regarding independent claim 43, Applicants traverse the rejection and submit that the complementary text channel of Campbell does not anticipate the "at least one datum" of claim 43. Campbell discloses that "[t]ext information of some complementary text channels may be formatted to supplement the television programs on its complementary program channel." (Campbell, col. 17, lines 28-31). In contrast, amended claim 43 recites "selecting said at least one datum for at least one of simultaneous and sequential presentation with mass medium programming . . .". Campbell's complementary text channel is merely an alternate channel that displays additional textual data, independent of the program channels, for all subscribers with appropriate access and authorization. The "at least one datum with independent

receiver specific relevance" of claim 43, however, is actually selected on the basis of information received from the processor based on the step of controlling the processor.

Campbell also does not teach or suggest inputting any "instruct-to-react signal" which is effective to control the processor to output specific information in response. Therefore, Campbell fails to teach or suggest the steps of inputting, controlling, selecting based on the "instruct-to-react signal" as recited in claim 43.

Because Campbell fails to disclose every element of the claimed invention of independent claims 3, 13, 17, 19, 22, 27, 35, 39, and 43, Campbell does not anticipate these claims. The remaining dependent claims are not anticipated for at least the reasons proffered regarding their respective independent claims. Accordingly, Applicants respectfully submit that Campbell does not anticipate claims 3-46 of the present application and respectfully request reconsideration of the rejection under 35 U.S.C. § 102(a).

Applicants respectfully submit that each of the pending claims clearly contain elements or an element which is absent in the cited reference, therefore precluding a rejection under 35 U.S.C. § 102. Applicants further submit that the subject matter of each claim would not have been obvious to one of ordinary skill in the art at the time the invention was made. Applicants respectfully request that the rejections of the pending claims be withdrawn and all claims be permitted to issue.

## CONCLUSION

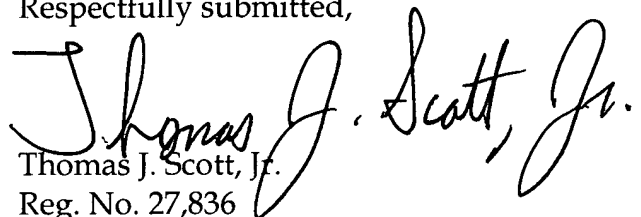
In accordance with the foregoing it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, that all pending claims patentably distinguish over the prior art, taken in any proper

combination. Thus, there being no further outstanding objections or rejections, the application is submitted as being in a condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for telephone interview to discuss resolution of such informalities.

Date: February 23, 1998  
**HOWREY & SIMON**  
1299 Pennsylvania Avenue, NW  
Washington, D.C. 20004  
Tel: (202) 783-0800

Respectfully submitted,

  
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## APPENDIX A



## **APPENDIX A**

The following foreign reference has been cited by Applicants in the Information disclosure Statements filed 12-11-95, 12-22-95, 2-6-96, 4-17-96 and 4-7-97. Applicants have further included the following relevancy statement as well as an English abstract (in the case of foreign patents), thus meeting the requirements as set forth in 37 CFR 1.98 and MPEP § 609.

### **For the Information Disclosure Statement filed 12-22-95:**

**23 38 330      February 13, 1975      Germany**

This reference discloses television receivers that transmit control signals to a decoder/processor combination.

### **For the Information Disclosure Statement filed 2-6-96:**

**61-050470      March 12, 1986      Japan**

This reference discloses a program engagement device that displays the program content at a television receiver and includes a display output control device.

**60-61935      April 9, 1985      Japan**

This reference discloses a system that generates, detects, communicates, and/or converts digital signals.

### **For the Information Disclosure Statement filed 4-17-96:**

**2 058 681      June 15, 1972      Germany**

This reference discloses a television mode arrangement for transmitting, receiving, and presenting coded information.

**For the Information Disclosure Statement filed 4-7-97:**

**0 020 242      December 10, 1980      European**

This reference discloses a teletext character alignment process.

**0 046 108      February 17, 1982      European**

This reference discloses a integrated circuit interface between a television receiver and recorder.

**0 049 184      April 7, 1982      European**

This reference discloses a pocket teaching aid using a television receiver with a teletext system.

**0 055 167      June 30, 1982      European**

This reference discloses a teletext CRT display for messages from a composite memory.

**0 077 712      April 27, 1983      European**

This reference discloses a multi-channel digital packet television broadcasting system.

**0 078 185      May 4, 1983      European**

This reference discloses a digital packet broadcasting system using television transmissions.

**2 496 376      June 18, 1982                  France**

This reference discloses a teletext display of data on the television screen.

**2 516 733      May 5, 1983                          France**

This reference discloses an error controller for a teletext television decoder.

**2 823 175      November 29, 1989                  Germany**

This reference discloses a teletext information display for television transmission.

**24 53 441      May 13, 1976                          Germany**

This reference discloses a wideband signal transmission with digital to image signal conversion.

**DE 30339949 May 6, 1982                  Germany**

This reference discloses a method for the generation of teletext display having a color character contrast.

**DE 3112249    October 7, 1982                          Germany**

This reference discloses a processing signals from either a colored television receiver or from a video text decoder.

**DE 3020787    December 17, 1981                  Germany**

This reference discloses a television transmission system that sends extra data during a blanking period.

**WO 80/00292 February 21, 1980 Japan**

This reference discloses a decoder for a television receiver that has a color component that splits signals and recombines the signals into a composite drive current signal.

**WO 83/00789 March 3, 1983 Japan**

This reference discloses an image display unit which displays received image signals via a memory, wherein the image signals include teletext displays of weather reports or television programs.

**Graf, P.H., "Antiope-Uebertragung fuer Breitbandige Videotex-Verteildienste," 1981.**

This reference shows an Antiope demodulator/detector.

**Heller, Arthur, "VPS - Ein Neues System Zuragsgesteuerten Programmanfzeichnung, Rundfunk technisde Mitteilungen, pp. 162-169.**

This reference discloses a decoding system for use with a VCR.

**Marti, B et al., Discrete, service de television cryptee, Revue de radiodiffusion - television (1975), pp. 24-30.**

This reference discloses an analog decryption system.

**Strauch, D., "(Las Media De Telecommunication Devant la Rapture. Les Nonvellas Methodes Presentees a L'Eposition International 1979 de Radio (Et Television)) 1979.**

This reference is a discussion of videotext, teletext, ceefax, oracle, and antiope.

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## APPENDIX B

**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

**CITATION FORM**

|   |                          |
|---|--------------------------|
| Attorney Docket No.<br>05634.150                    | Serial No.<br>08/446,431 |
| Applicant(s)<br>John C. Harvey and James W. Cuddihy |                          |
| Filing Date<br>May 22, 1995                         | Group Art Unit<br>2733   |

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|                     | 3,107,274        | October 15, 1963   | Roschke          | 178/5.1            |                 |
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|                     | 3,746,799        | July 17, 1973      | Gentges          | 178/22             |                 |
|                     | 3,755,624        | August 28, 1973    | Sekimoto         | 178/69.5 TV        |                 |
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|                     | 3,813,482        | May 28, 1974       | Blonder          | 178/5.1            |                 |
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\* If Pertinent

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|                     | 1,396,981          | June 11, 1975       | United kingdom | H04H 1/00          | X           |    |
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